

REMARKS

By this Amendment, Applicants amend claims 1-3, 6-10, and 13-19. Claims 1-19 remain pending in this application.

In the Office Action,¹ the Examiner rejected claims 1-7, 9, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 14-19 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter; and rejected claims 1-13 under 35 U.S.C. § 102(e) as being anticipated by Liu (U.S. Patent No. 6,782,198).

At the outset, Applicants note that the Examiner did not return an initialed copy of the PTO 1449 Form filed with the Information Disclosure Statement (IDS) of December 19, 2003. For the Examiner's convenience, Applicants include a copy of the PTO 1449 Form that was attached to the IDS. Applicants request that the Examiner consider the listed documents and return the Form including appropriate notations indicating the Examiner's consideration.

Applicants respectfully traverse the rejection of claims 1-7, 9, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite. With regard to claims 1, 2, 3, 6, and 7, Applicants disagree that because "the word 'means' is not preceded by ... any word(s) in an attempt to use a 'means' clause to recite a claim element as a means for performing a specification function" that "it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See Office Action, page 2.

The Examiner's rejection is improper, because, as discussed in MPEP § 2181, a claim invokes 35 U.S.C. § 112, sixth paragraph, if it (1) uses the phrase "means for " or

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

"step for "; (2) the "means for " or "step for " must be modified by functional language; and (3) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function. Claims 1, 2, 3, 6, and 7 clearly meet these requirements.

As set forth in MPEP § 2181, Applicants may use traditional "means for" or "step for" language, as well as other alternatives. For example, an Applicant may recite "ink delivery means," which is considered equivalent to "means for ink delivery." See MPEP § 2181. However, in the above example, an Applicant is not required to recite "ink delivery means" instead of "means for ink delivery," so long as the words preceding or following the word "mean" conveys a function to be performed. As noted in MPEP § 2181, the phrases are equivalent and both properly constitute a means plus function claim. The rejection made by the Examiner does not apply because it concerns a situation where an Applicant chooses to place functional words preceding the word "means." See MPEP § 706.03(d) ("In general, if the phrase can be restated as 'means for _____,' and it still makes sense, it is definite. In the above example, 'latch means' can be restated as 'means for latching.'"). However, that is not the case here, and therefore, the rejection is improper.

Applicants' claims clearly meet the requirements of the "means for" claim structure. For example, claim 1 recites "means for setting," "means for sharing," and "means for ... outputting." Each "means for" is followed by appropriate functional language. Further, claims 2, 3, 6, and 7 include "means for" recitations which, while of differing scopes, following a proper "means for" claim structure. Claims 4 and 5 depend from independent claim 3, and Applicants have also amended claims 9 and 15 for

further clarity to remove the “means for” recitations. Accordingly, the Examiner should withdraw the rejection of claims 1-7, 9, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicants respectfully traverse the rejection of claims 14-19 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. To clarify the computerized aspects of the claims, Applicants have amended claims 14-19 to recite a “computer readable medium.” Applicants note that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.” MPEP § 2106(IV)(B)(1)(a). Applicants further note that “computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103.” In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995). Accordingly, since claims 14-19 has been amended to clarify the computerized features of the claim, the claimed invention is well within the requirements of 35 U.S.C. § 101. Accordingly, Applicants request that the Examiner withdraw the rejection of claims 14-19 under 35 U.S.C. § 101.

Applicants respectfully traverse the rejection of claims 1-13 under 35 U.S.C. § 102(e) as being anticipated by Liu (U.S. Patent No. 6,782,198). In order to properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *See*

M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1, as amended, calls for a combination including, for example, “an optical path control device comprising a communication interface which transfers information between an IP router or another device and an operator, an optical path control section, a structure control table, an optical path control table and an optical path shared table, and said optical path control device controlling an optical path setting in accordance with information transferred via a communication interface.” Liu fails to teach a combination including at least this element of claim 1.

Liu discloses a link failure detector and a failure correction apparatus. See col. 1, lines 49-51. In the Liu system, a “fault recovery apparatus in the network 150 includes a link failure detector 230 in at least one link 160 or 170.” See col. 7, lines 16-18. Further, a “link failure signal S_F is produced by the link failure detector responsive to every signal S_L that enters the link 105.” See col. 7, lines 35-40. Also, a “fault correction apparatus 240 is logically disposed between the demand identification apparatus 142/receiving apparatus 144 pair and an adjacent link.” See col. 7, lines 50-52. If “link 160 ceases to be operational for channel y of first parity, then signal S_{L1} on the first parity network 180, which enters link 160, is not successfully transmitted....” See col. 8, lines 16-19. In “response to this failure, the link failure detector 230 generates a signal S_F indicative of failure and, upon receipt of this signal S_F , crossbar 250 in failure correction apparatus 240 switches to the cross-state. The crossbar 250 remains in this state until it is reset to the transmission through state.” See col. 8, lines

19-24. These teachings of failure detection as performed by the Liu system, however, do not constitute Applicants' claimed "optical path control device," which comprises "a communication interface which transfers information between an IP router or another device and an operator, an optical path control section, a structure control table, an optical path control table and an optical path shared table, and said optical path control device controlling an optical path setting in accordance with information transferred via a communication interface," as recited in claim 1. Since Liu does not teach each and every element recited in the claim, Liu cannot anticipate claim 1. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 102(e).

Independent claims 2, 3, 6, 7, 8, 9, 10, and 13, while of a different scope from claim 1 and each other, also have been amended to include recitations similar to those of claim 1. Accordingly, Liu does not teach all of the elements of independent claims 2, 3, 6, 7, 8, 9, 10, and 13. Dependent claims 4, 5, 11, and 12 depend from independent claims 3 and 10, and are also not taught by Liu at least due to their dependence. The Examiner should therefore withdraw the rejection of claims 2-13 under 35 U.S.C. § 102(e).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 25, 2005

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Attachment: Copy of PTO 1449 Form for IDS of December 19, 2003 (1 page)